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10/715,581	11/18/2003	Donald E. Weder	8404.025	4749

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EXAMINER

FIDEI, DAVID

ART UNIT PAPER NUMBER

3728

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/715,581

Applicant(s)

WEDER, DONALD E.

Examiner

David T. Fidei

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/18/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### ***Claim Construction***

1. In analyzing applicant's invention as set out in the pending claims, the examiner sets forth the following to aid in understanding the application of the prior art herein. Claims are to be given their broadest reasonable during prosecution, see *In re Priest*, 582 F.2d 33, 37 USPQ 11, 15 (CCPA 1978), and limitations from the specification will not be read into the claims, see, e.g. *In re Prater*, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969). Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997), see MPEP 2106.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Lopez (Patent no. 5,199,215). Claim 1 recites "a liner for a container, comprising: a backing having a first side and a second side; a porous covering connected to the second side of backing; a seed carrier disposed between the backing and the covering, the seed carrier fabricated of a moisture retaining material; and a plurality of seeds embedded in the seed carrier such that, upon germination, the seeds will sprout through the covering so as to form a natural tuft".

Lopez discloses a liner in figure 1 comprising: a backing 11 having a first side and a second side (not numbered) ; a porous covering 14 connected to the second side of backing; a seed carrier 13 disposed between the backing and the covering, the seed carrier fabricated of a moisture retaining material (see col. 3, line 23 and claim 1 where peat moss is claimed as the third matrix having the seeds); and a plurality of seeds embedded in the seed carrier such that, upon germination, the seeds will sprout through the covering so as to form a natural tuft.

As to claim 3, the mesh porous covering film 14, see col. 3, line 31, is considered as providing a plurality of perforations.

As to claim 4, the member 14 of Lopez is described as a fabric, see col. 3, lines 25. Wordsmyth on-line dictionary defines fabric as "cloth made by weaving, knitting, or felting fibers".

As to claim 9, the porous mesh 14 defines at least a central opening extending therethrough.

4. Claims 1, 3, 6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kouno (Patent no. 4,808,430). As to claim 1, Kouno discloses a liner in the prior art of figures 1-3 comprising: a backing 2 having a first side and a second side (not numbered) ; a porous covering 1 (by virtue of openings 5) connected to the second side of backing; a seed carrier 6 (of gel as recited in claim 6) disposed between the backing and the covering; and a plurality of seeds 7 embedded in the seed carrier. Hence, Kouno discloses a prior art product where the claimed and prior art products are identical or substantially identical in structure or composition, which establishes a prima facie case of anticipation, see M.P.E.P. § 2112.01.

As to claim 3, porous covering film 1 is provided with a plurality of perforations 5.

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As to claim 9, the opening 5 of figure 2 and 3 comprises a central opening extending therethrough.

5. Claims 11, 12, 21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Tietz et al (Patent no. 2,876,588). Claim 11 recites and Tietz et al discloses a “container (formed by the sealed margins of sheets 6 and 13) in combination with a liner for lining an interior surface of the container, the liner comprising: a backing 7 having a first side and a second side; a porous covering 11 connected (joined or linked) to the second side of backing; a seed carrier 8 disposed between the backing 7 and the covering 11, the seed carrier 8 fabricated of a moisture retaining material; and a plurality of seeds 9 embedded between the backing and the porous covering such that, upon germination, the seeds will sprout through the porous covering so as to form a natural tuft”.

As to claims 12 and 23, the sheets 6 and 13 are folded and sealed together with a suitable adhesive, col.2, lines 23-27. The bed or liner is thus sealed in an impervious wrapped where the backing is bondably connected to the interior of the container by “adhesive”.

As to claim 21, the combination further comprises a central opening extending therethrough as shown in figure 5.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 5, 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez (Patent no. 5,199,215) as applied to claims 1, 3 and 4 above, and further in view of Chamouland (Patent no. 5,401,281). The difference between claims 2 and 10 resides in “the liner

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of claim 1 wherein the backing has a bonding material disposed thereon" (claim 2) and the bonding material is an adhesive (claim 10). Lopez provides no disclosure of how the backing and porous members are connected.

Chamouland teaches the fabrication of a plant mat where different film layers 1, 2 and 6 are joined by gluing, see col. 6, lines 18. It would have been obvious to one of ordinary skill in the art to construct the backing 11 having an adhesive thereon as taught by Chamouland, in order to bond the layers together.

As to claims 5, 7 and 8, the particular carrier medium and type of seed used is a matter of design choice dependent upon the type of vegetation one desires to grow or the particular carrier medium available. Since these specific parameters impart no critical or expected result, one skilled in the art would have found it to be within ordinary skill to use any carrier medium or seeds preferred.

8. Claims 11, 13, 14, 15, 16, 17-20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez (Patent no. 5,199,215) in view of Blatt (Patent no. 4,151,914). Lopez discloses a liner as claimed and described in paragraph 2 above. The difference between claim 11 and Lopez resides in a "container in combination with a liner for lining an interior surface of the container". A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim, see M.P.E.P. § 2114.

Blatt teaches the combination of a roll and container and Lopez figure 3 discloses the liner in roll form. It would have been prima facie obvious to one of ordinary skill in the art to modify Lopez by constructing a container in combination with the liner as suggested by Blatt, in order to provide medium for storage and transportation of the roll or rolls.

As to claim 13, Wordsmyth on-line dictionary defines a "film" as a thin, membranous layer which categorizes backing 11 of Lopez.

As to claim 14, the mesh porous covering film 14, see col. 3, line 31, is considered as providing a plurality of perforations.

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As to claim 15, the member 14 of Lopez is described as a fabric, see col. 3, lines 25. Wordsmyth on-line dictionary defines fabric as "cloth made by weaving, knitting, or felting fibers".

As to claim 16, peat moss is a moisture retaining material (see claim 1 where peat moss is claimed as the third matrix having the seeds)

As to claims 17-20, the difference between claims 17-20 Lopez resides in the seed carrier material (spongy cellulose and gel) and the specific seed (fern and winter wheat) used. The particular carrier medium and type of seed used is a matter of design choice dependent upon the type of vegetation one desires to grow or the particular carrier medium available. Since these specific parameters impart no critical or expected result, one skilled in the art would have found it to be within ordinary skill to use any carrier medium or seeds preferred.

As to claim 21, the porous mesh 14 defines at least a central opening extending therethrough.

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 10 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The bonding material of claims 10 and 23 has no antecedent basis in claims 1 and 11, respectively.

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,065,601. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are broader than those previously patented thereby effectively extending the subject matter of the previous patented claims.

13. Claims 1-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,293,401. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are broader than those previously patented thereby effectively extending the subject matter of the previous patented claims.



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***Information Disclosure Statement***

14. The documents cited in the Information Disclosure Statement filed 11/18/2003 that are lined through indicate the Examiner was unable to locate copies of such documents. Applicant is requested to re-submit non-patent literature if consideration is desired.

**REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION**

15. “In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to every ground of objection and rejection in this Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. The applicant’s or patent owner’s reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. The reply must be reduced to writing (emphasis added)”, see 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

Pointing out specific distinctions means clearly indicating in the written response what features/elements or distinctions have been added to the claim/claims, where support is found in the specification for such recitations and how these features are not shown, taught, obvious or inherent in the prior art.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner’s action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

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The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)" (emphasis mine), see MPEP 706.07(a).

#### Conclusion

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Patent Electronic Business Center (EBC) will be the organizational contact for Patent Business external customers regarding questions about IFW images viewed in Private PAIR. External customers should be directed to EBC representatives, who can be reached at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: [ebc@uspto.gov](mailto:ebc@uspto.gov). Additional information is available on the Patent EBC Web site at: <http://www.uspto.gov/ebc/index.html>.

In accordance with the USPTO E-Patent Reference program, this program: (1) provides downloading capability of the U.S. patents and U.S. patent application publications and (2) ceases mailing paper copies of U.S. patents and U.S. patent application publications with office actions. Beginning July 2004, paper copies of cited U.S. patents and U.S. patent application publications **will cease to be mailed to applicants with Office actions**. Examiner's are advised to inform applicant's that U.S. patents and U.S. patent application publications not supplied with Office actions, are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site

([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Any inquiries about the use of the Office's PAIR system, should be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197, not the Examiner.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning the MERITS of this examination from the examiner should be directed to David T. Fidei whose telephone number is (703) 308-1220. The examiner can normally be reached on Monday, Thursday and Friday 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Effective Monday morning, August 4, 2003, all official faxes for the TCs will be received in one central location in the Office. In cooperation with the Customer Service Goal Team, a new central official fax number (703-872-9306) has been established for use by the TCs. An OG notice will be issued and the Website updated to alert PTO customers of the new fax number. Official standalone (non-RightFax) fax machines will be removed from the TC fax centers, their phone numbers auto-forwarded to a single RightFax account, and faxes printed in the centralized fax center.

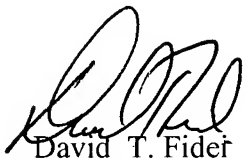
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Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8497
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
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David T. Fider  
Primary Examiner  
Art Unit 3728

dtf  
June 24, 2004